



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,296	12/11/2000	Andrew John Mark Miles	36-1412	7040

7590 03/25/2004

Nixon & Vanderhye
8th Floor
1100 North Glebe Road
Arlington, VA 22201-4714

EXAMINER

BAROT, BHARAT

ART UNIT	PAPER NUMBER
----------	--------------

2155

5

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,296

Applicant(s)

MILES ET AL.

Examiner

Bharat N Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 16-20, 22 and 23 is/are rejected.
- 7) ☒ Claim(s) 14 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

2. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Objection

3. Claims 14 and 21 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are not further treated in the merit. Appropriate corrections are required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 12, 16, and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen (U.S. Patent No. 5,948,054). Nielsen's patent meets all the limitations for claims 1-3, 12, 16, and 18-19 recited in the claimed invention.

6. As to claim 1, Nielsen discloses a requirements matching server for use in a requirements matching system comprising at least one requirements matching server accessible by means of a communications network, the requirements matching server (figure 1; and column 5 lines 9-50) comprising: an input for receiving a user request message by means of the communications network, wherein a user request message comprises a specification of user requirements and an identifier for a response contact (figure 5; and column 6 lines 43-61); routing means for forwarding a received specification of user requirements to a destination determined by the routing means and accessible by means of the communications network (figures 6 and 8A; column 6 line 62 to column 7 line 18; and column 8 lines 50-63), wherein the routing means comprise: a store for storing at least one routing rule for controlling the routing means, wherein a routing rule comprises a specification of requirements to be routed and an identifier for a corresponding destination (figures 2-4; and column 5 line 51 to column 6 line 36); comparison means for comparing a specification of user requirements conveyed by a

received user request message with a specification of requirements to be routed as defined in a stored routing rule and, in dependence upon the result of the comparison, identifying a corresponding destination for the forwarding of the specification of user requirements (figure 7; and column 7 line 21 to column 8 line 49); and forwarding means for transmitting, by means of the communications network, a message conveying a specification of user requirements to a destination identified by the comparison means (figure 8a; and column 8 lines 50-63).

7. As to claims 2-3, Nielsen discloses that the routing means further include registration means arranged, on receipt of a message conveying a routing rule, to store the routing rule in the store, wherein the registration means are further arranged to generate a message including a message routing rule and to transmit the generated message to another requirements matching server (figures 2-4 and 8B; column 5 line 51 to column 6 line 36; and column 8 line 64 to column 9 line 24).

8. As to claim 12, it is also rejected for the same reasons set forth to rejecting claim 1 above.

9. As to claims 16 and 19, they are also rejected for the same reasons set forth to rejecting claim 1 above, since claim 16 is merely a method of operation for the apparatus defined in the claim 1.

10. As to claim 18, Nielsen discloses that each the specification of user requirements and of supplier deliverables is defined according to the same predetermined representation scheme (figures 5-6; and column 6 line 43 to column 7 line 18).

Claim Rejections - 35 USC § 103(a)

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 4-6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (U.S. Patent No. 5,948,054) in view of Miloslavsky (U.S. Patent No. 5,765,033).

13. As to claim 4, Nielsen does not disclose that an information extraction means for extracting a predetermined type of information from a received user request message, and for storing the extracted information.

Miloslavsky disclose a requirements matching server (figure 1) including: information extraction means for extracting a predetermined type of information from a received user request message, prior to forwarding by the routing means of a specification of user requirements contained therein, and for storing the extracted information; and means responsive, on receipt of a message conveying a request to supply the extracted information, to transmit to the sender of the extracted information request message a message including the extracted information (figure 2; column 2 lines 10-30; and column 4 line 20 to column 5 line 25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Miloslavsky stated above in the requirements matching server of Nielsen as stated above for extracting a predetermined type of information from a received user request message, and for storing the extracted information because it would have increased over all system efficiency and performance by reducing network latency and processing time.

14. As to claim 5, Miloslavsky discloses that the predetermined type of information is the identifier for a response contact of the specification of user requirements conveyed by a received user request message (figure 2; and column 4 lines 4-51).

15. As to claim 6, Nielsen discloses a requirements matching server (figure 1) including: billing means for raising a charge in respect of the sender of each request to supply extracted information (column 2 lines 33-41; and column 4 lines 50-59).

16. As to claim 17, it is also rejected for the same reasons set forth to rejecting claim 4 above, since claim 17 is merely a method of operation for the apparatus defined in the claim 4.

17. Claims 7-11, 20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (U.S. Patent No. 5,948,054).

18. As to claims 7-8, above remarks rejecting claim 1 equally apply here. Nielsen does not explicitly disclose a requirements matching system comprising a plurality of requirements matching servers.

However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a plurality of requirements matching servers incorporate with the system of Nielsen as stated above because doing so would have made the system more efficient and utilizable. Duplicate parts for multiple effects are generally not given patentable weight or would have been obvious for improvements.

19. As to claim 9, Nielsen discloses a system including at least one user access server arranged with access to at least one requirements matching server of the system, the at least one user access server having a user interface for receipt of a specification of user requirements and means for generating a user request message comprising the received specification of user requirements and an identifier for a response contact, and for forwarding the generated message to the at least one requirements matching server (figures 5-8s; and column 6 line 37 to column 9 line 24).

20. As to claim 10, Nielsen discloses a system including at least one server providing a user interface to enable a user to receive, from one or more servers of the system of servers, user request messages conveying a specification of user requirements relating to a predetermined category of requirements (figures 5; and column 6 lines 43-61).

21. As to claim 11, Nielsen discloses that each the requirements specification is defined according to a predetermined requirements representation scheme (figures 5-6; and column 6 line 43 to column 7 line 18).

22. As to claim 20, Nielsen discloses that servers of the system are arranged to forward specifications of user requirements describing a particular category of requirements, conveyed by received user request messages to a predetermined respective server of the system (figures 5-7; and column 6 line 43 to column 8 line 49).

23. As to claims 22-23, above remarks rejecting claims 1 and 7-8 equally apply here. Nielsen does not explicitly disclose a requirements matching system use with an electronic purchasing or trading environment.

However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the requirements matching system of Nielsen as stated above with the electronic purchasing or trading environment because doing so would have made the system more utilizable.

Additional References

24. The examiner as of general interest cites the following references.

- a. Baker et al, U.S. Patent No. 5,678,041.
- b. Akizawa et al, U.S. Patent No. 5,548,724.

Contact Information

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (703) 305-4092. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, can be reached at (703) 308-6662. A central official fax number is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

Art Unit 2155

March 19, 2004

Bharat Barot.
BHARAT BAROT
PRIMARY EXAMINER